

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte J. CARL COOPER

Appeal No. 2006-0683
Application 08/824,496

ON BRIEF¹

MAILED

MAY 11 2006

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before THOMAS, HAIRSTON, and KRASS, Administrative Patent Judges.
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1 through 38 and 40 through 53, the examiner having objected to claim 39 as set forth in the final rejection as well as the advisory action.

¹ The present panel has only recently received this appeal for decision.

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Representative independent 1 claim is reproduced below:

1. A system for providing a mix minus signal from a delayed feedback signal and a relatively undelayed talent signal including in combination:

a cancellation circuit responsive to said talent signal to delay said talent signal in a variable delay and to gain adjust said talent signal in delayed or undelayed form in a variable gain circuit thereby providing a cancellation signal, with the amount of said delay or gain responsive to human operator adjustment;

 said feedback signal and said cancellation signal being applied to a combining circuit to provide said mix minus signal with said feedback signal being applied without the use of a variable delay circuit.

The following references are relied on by the examiner:

Davidson Jr. et al. (Davidson Jr.)	4,025,724	May 24, 1977
Agrawal et al. (Agrawal)	4,268,727	May 19, 1981
Umemoto et al. (Umemoto)	5,636,323	Jun. 3, 1997
	(§ 102(e) date Sept. 19, 1994)	
Tanno	S58-0170298	Oct. 6, 1983
(Japanese Kokai Patent Application)		

Kuo, Sen M. "Active Noise Control Systems", 1996 (Preface by authors dated October 1995), pp 35-36.

There are six separately stated rejections of the claims on appeal. The examiner has rejected claims 1 and 4 through 19 [sic 19 only] as being indefinite within the second paragraph of 35 U.S.C. § 112, second paragraph. Claims 2 through 7, 18

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through 27, 29 through 31, 37 and 38 (as correctly set forth in the final rejection but incorrectly listed at page 4 of the answer) under 35 U.S.C. § 102(e) as being anticipated by Umemoto. Claims 2 through 7, 10, 11, and 16 through 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Agrawal. In a fourth stated rejection, the examiner rejects claims 8 through 17, 28 and 32 through 36 under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Umemoto in view of Kuo. Claims 1 through 17, 40, 41 and 43 through 47 also stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Tanno in view of Davidson and Kuo. Lastly, claims 18, 42 and 48 through 53 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Tanno in view of Davidson and Kuo as set forth in the last stated rejection, further in view of in the alternative Agrawal or Umemoto (further in view of Davidson).

Rather than repeat the positions of the appellant and the examiner, reference is made to the brief and reply brief for the appellant's positions, and to the answer for the examiner's positions.

OPINION

We reverse all rejections of all claims on appeal.

First, we address the rejection of dependent claim 19 under the second paragraph of 35 U.S.C. § 112. We note the examiner's views (answer pages 4 and 10) that appellant has not distinctly claimed and particularly pointed out his own invention since this dependent claim 19 requires both the delay and the gain of (independent claim 1) to be automatically adjusted, whereas the parent claim 1 requires that either the delay or the gain is human operator adjustable. The approach followed between the two claims only appears to be logically inconsistent. The showing in the first embodiment of figure 2 is only manually adjustable for both gain and delay by the use of the structure in element 16.

On the one hand, where there is only automatic adjustability of gain and delay in figure 4, the preferred embodiment, the figure 3 embodiment permits the manual adjustability in element 16 of the variable gain only and automatic adjustability of the variable delay and gain.

Appellant's remarks as to this rejection at pages 9 and 13 of the brief are noted but somewhat misplaced. Appellant's claimed invention must be consistent with the disclosed approaches or embodiments in figures 2 through 4. Appellant is correct in stating at page 13 of the brief that claim 1 does not recite "either delay or gain adjustment as the examiner states in the rejection." Claim 1 does not use the word either. This claim only recites the connective "or". Figure 3 shows two alternate embodiments. On the one hand, while figure 3 permits an automatic adjustability of both variable gain and variable delay by the use of the optional alternate electronic controls 15a, 15b, this figure does permit a manual adjustability of the variable delay, a condition which is inclusive within the subject

matter of independent claim 1 on appeal. Thus, claim 1 reads on the figure 2 and figure 3 embodiments. Dependent claim 19 reads only on the figure 3 alternate embodiments. As such, the rejection must be reversed.

To simplify our analysis with respect to all art rejections that remains for our consideration under 35 U.S.C. § 102 and 35 U.S.C. § 103, we find ourselves in general agreement with the positions set forth by appellant in summary form at pages 1 through 3 of the reply brief which we reproduce here:

Applicant's claims utilize terms which are terms of art having particular meaning to persons of ordinary skill in the art and are accordingly pointed out and/or defined in applicant's specification. Terms of art which would be known to the person of ordinary skill as of the filing date of the application include "director", "program" or "program signal", "program audio" and "interrupted feed back" and its abbreviation "IFB". See Cooper 9/9/02 Declaration paragraphs 6-9. Applicant, choosing to be his own lexicographer, has specifically defined other claim terms in the specification. These terms include: "feedback signal", "talent", "talent signal", "mix minus" and "mix minus signal" and "cancellation signal". See Cooper 9/9/02 Declaration paragraphs 10-15.

The claims at issue utilize one or more of these terms of art or specially defined terms. In particular, all of the claims use the term "mix minus signal" which the person of ordinary skill in the art would know from the teachings of the present invention to be a special signal including program audio with the talent's voice removed or reduced.

Program audio in turn is also a specially defined term, as is program signal. For example the term "program" or "program signal" as used in the claims is a term of art referring "to a mixture of electronic signals including the talent signal which is recorded or broadcast" productions of television and radio like programs as set forth at the last three lines of page 6 of the specification. The person of ordinary skill in the art would know that none of the signals which occur in telephone systems of the type described in the present prior art are a "program signal" or "mix minus signals" as that term is defined in the instant specification and as used in the rejected claims.

The examiner has failed to allow applicant to be his own lexicographer. The examiner fails to recognize and use the proper definition of various claim terms which are specially defined in the specification. These claim terms in turn define the scope of the claims. For example, at page 10, third paragraph, the examiner's answer states:

The appellant's argument is not persuasive because the claims do not recite such limitations, and certainly, the term "program signal" in its broadest reasonable interpretation need not be limited to what Appellant has argued; if Appellant wishes for the term to be limited to something specific, the details must be recited to be given weight in the case of so broad a term as "program signal".

Appellant believes the examiner's position is incorrect. Words in a claim will be given their ordinary and accustomed meaning, unless it appears that the inventor used them differently. Here the applicant uses claim terms differently (and more narrowly) than the examiner. Claims are to be construed in light of the specification, and an inventor may be his own lexicographer. Here many claim terms are clearly and specifically defined in the

specification and/or as terms of art. These terms should be given the "broadest reasonable interpretation" however the examiner goes far beyond that broadest reasonable interpretation by ignoring the definition provided in the specification and ignoring what one of skill in the art would know the claim terms to mean from the usage in the art and definitions given in the specification. Going beyond what the person of ordinary skill would know is not reasonable. [footnotes omitted]

The examiner's apparent requirement that each and every claim term be defined in detail in the claim departs from well settled practice and law. Patent documents are written for persons of ordinary skill in the field of art to which the invention pertains. Patent claims are not required to be written as a comprehensive tutorial and treatise for the generalist, instead they are concise statements written in terms known and understood by the person of ordinary skill in the art from their knowledge taken in conjunction with the description and definitions given in the specification.

These remarks from the reply brief summarize the continued positions taken by appellant in the principal brief on appeal regarding terms that are claimed, terms that may be specifically defined by appellant as his own lexicographer which are claimed, all of which set the proper context in which the subject matter of each claim on appeal must be considered when applying prior art. As the principal brief and remarks in the reply brief make note, the feature of a mix minus signal is recited in each

independent claim on appeal as is the so-called talent signal, both of which have special meaning in the art. No program signal per se has been recited in the independent claims on appeal, but the term mix minus signal is as just noted and it encompasses the meaning of the claimed feedback signal which is essentially defined in the sentence bridging specification pages 3 and 4. It appears to us that the examiner has not chosen art to apply that is in the context of the field of the invention or so related and argued as to address the explicit definitional requirements of each claim on appeal. The examiner has not followed the guidance provided by our reviewing court, for example, in Phillips v. AWH Industries, 415 F.3d 1303, 75 USPQ 1321 (Fed. Cir. 2005) (En Banc).

Moreover, the examiner's responsive arguments at pages 10 through 15 of the answer make specific reference to specific pages of appellant's arguments in the brief even by line number, yet the examiner fails to address within the noted pages and line numbers appellant's reference to and reliance upon his declaration under 37 CFR 1.132 filed on September 9, 2002 (as

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part of an amendment and remarks filed on the same date). The examiner presumably has not considered this declaration because it was filed in a response filed after the final rejection. However, the advisory action indicates that box 5 has been checked to reveal that the request for reconsideration had been considered but did not place the application in condition for allowance, and block 7 has been checked as well indicating that the proposed amendment would be entered for purposes of appeal. There was no indication in the advisory action that the declaration associated with it was not also entered. As such, with this file history, the examiner failed to consider the declaration since it explicitly appears to have been entered into the record.

In the context of the rejections under 35 U.S.C. § 103 relying on Kuo, there appeared to be an open dispute as to the effective publication date of the excerpt from Kou's book. Page 1 at the top of the specification as filed indicates that appellant relies upon the provisional application filed on March

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14, 1996. The examiner's attempt to utilize the preface of Kuo's book to indicate an effective publication date of October 19, 1995 is ineffective to show the actual publication date as of that date. On the other hand, we have searched the Copyright Office Web site (www.copyright.gov) to search for the author in which we determined that the publication date of the Kuo's book in question was January 25, 1996, which date is before appellant's earliest effective filing date.²

Notwithstanding these considerations, the examiner's reliance upon Kuo is misplaced to the extent he relies upon it as a modifying method reference to Umemoto in the first stated rejection under 35 U.S.C. § 103. The examiner's analysis at page 6 of the answer in the statement of the rejection for this rejection essentially sets forth no reason or motivation analysis

² For the convenience of the reader we have enclosed as an appendix to this opinion the search results from our inquiry online to the Copyright Office to determine the publication date of Kuo's book as January 25, 1996.

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from which the artisan may have been apprised for combinability of the two references within 35 U.S.C. § 103. The examiner's continued reliance upon Kuo in the remaining two rejections under 35 U.S.C. § 103 is equally misplayed for the same reasons. Therefore, notwithstanding the propriety of the examiner to rely upon Kuo within 35 U.S.C. § 103 as prior art to appellant as evidenced above, the merits of the rejections themselves relying on Kuo are not sustainable.

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In view of the foregoing, the decision of the examiner rejecting claims 1 and 19 under the second paragraph of 35 U.S.C. § 112 is reversed. All remaining rejections of the other claims on appeal either under 35 U.S.C. § 102 or 35 U.S.C. § 103 are also reversed. Therefore, the decision of the examiner is reversed.

REVERSED

JAMES D. THOMAS)
Administrative Patent Judge)
KENNETH W. HAIRSTON)
Administrative Patent Judge)
ERROL A. KRASS)
Administrative Patent Judge)

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Registered Works Database (Author Search)

Search For: KUO, SEN M

1 Item

For a list of commonly used abbreviations that appear in the catalog record, [click here](#).

1. Registration Number: TX-4-249-049

Title: Active noise control systems : algorithms and DSP implementations /
Sen M. Kuo, Dennis R. Morgan.

Imprint: New York : J. Wiley & Sons, c1996.

Description: 389 p. & computer disk.

Claimant: John Wiley & Sons, Inc.

Created: 1995

Published: 25Jan96

Registered: 16Apr96

Author on © Application: coauthor of text and ill., in book only: AT&T IPM Corporation,
employer for hire of aDennis R. Morgan.

Special Codes: 1/B/L

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